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PTO/SB/21 (09-04)

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

26

Application Number

09/757,940

Filing Date

January 10, 2001

First Named Inventor

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Art Unit

3629

Examiner Name

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Attorney Docket Number

7208-77901-2

ENCLOSURES (Check all that apply)

☐ Fee Transmittal Form☐ Fee Attached☐ Amendment / Reply☐ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority Document(s)☐ Response to Missing Parts/ Incomplete Application☐ Reply to Missing Parts under 37 CFR 1.52 or 1.53☐ Drawing(s)☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a Provisional Application☐ Power of Attorney, Revocation Change of Correspondence Address☐ Terminal Disclaimer☐ Request for Refund☐ CD, Number of CD(s) _____☐ Landscape Table on CD☐ After Allowance Communication to TC☐ Appeal Communication to Board of Appeals and Interferences☐ Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)☐ Proprietary Information☐ Status Letter☒ Other Enclosure(s) (please identify below):

Reply Brief Under 37 C.F.R. 1.193(b)(1)

Remarks

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Date June 25, 2007

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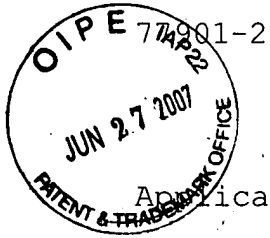
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June 25, 2007

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: R. Mark Halligan Art Unit: 3629
Serial No.: 09/757,940
Filed: January 10, 2001
For: METHOD AND APPARATUS FOR DOCUMENTATION, ANALYSIS,
AUDITING, ACCOUNTING, PROTECTION, REGISTRATION,
AND VERIFICATION OF TRADE SECRETS
Examiner: Mooneyham, J.
Attorney
Docket No.: 77901-2

REPLY BRIEF UNDER 37 CFR §1.193(b) (1)

Mail Stop: Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Examiner's Answer of April 25, 2007,
applicant responds as follows.

With regard to the rejection of Claims 96-101, 103-110
and 112-118 under 35 USC §112 first paragraph, in the Examiner's
Answer, Examiner argues (pages 13-14) that "concrete guidance or
direction to enable one skilled in the art to make or use the
invention" is not provided in the disclosure.

What is claimed in the independent claims is a method for
aggregating six separate judgments for each trade secret (judgments
which users skilled in the art of evaluating trade secrets
generally know how to make) and then ranking the portfolio of trade
secrets based on the aggregated score.

Applying the numeric values of 1 through 5 to the answers contained in the questionnaire of Table C of the specification (pages 20-22), as directed on page 20 of the specification, calculating the geometric mean of the numeric values for the answers received from the user, and ranking the trade secrets on the basis of the resulting score for each trade secret defines the output for a specific embodiment of the invention.

Creating a system to perform these claim steps of the independent claims from the disclosure alone is a relatively simple exercise for one skilled in the art of computer programming, but a complete functional specification for a specific embodiment of the invention is included in Appendix I as further guidance.

The "such as" and "may be" language of the specification to which Examiner objects is used merely to incorporate other possible embodiments of the invention, in which, for example, rankings on the basis of 1 through 4 or 1 through 6 may be used.

Examiner's rejection for a lack of enablement to make the invention is therefore unsupported, is incorrect and should be overturned.

Examiner's argument in the Answer for rejection for a lack of enablement to use the invention ultimately hinges on two main points: the alleged failure to provide sufficient guidance or direction on the 1 to 5 scale, and the subjective nature of the information input under the claimed invention in response to the questionnaire provided to the user in the first claim step of each

of the independent claims.

With regard to the first point, in the Examiner's Answer, "the Examiner asserts that the appellant does not provide sufficient guidance or direction as to the actual numerical scale being used in the invention or how the scale is to be applied" (Examiner's Answer, page 13). However, the 1 to 5 scale is well understood by the public at large, and even more so to those skilled in the art of evaluating trade secrets, who are either technical or legal people, including engineers, attorneys and judges. A Google search turns up 1.4 million web page hits for "1 to 5 scale", "scale of 1 to 5" and "scale from 1 to 5" using either the numerals 1 and 5 or the words 'one' and 'five'. Clearly, the 1 to 5 scale is in common use within the English language and is well understood by the public. No further guidance or direction is necessary.

Examiner states that "the scale of one to five has not been defined" (Examiner's Answer, page 17). Appellant disagrees, and asserts that a "scale of one to five" is common English usage and is all the definition that is required. The American Heritage Dictionary notes as one definition for "scale": "A progressive classification, as of size, amount, importance, or rank: *judging divers' performances on a scale of 1 to 10.*" Here the concept of a "one to n" scale is so assumed to be a common part of the language that it is used as an example to illustrate the definition.

Further on the one to five scale, Examiner states:

"Moreover, it is not that individuals have little trouble ranking items on a scale of one to five, it is the fact that the scale of one to five has not been defined. What defines a one or a two? What does a one or a five mean? How is the scale to be applied?" (Examiner's Answer, page 17). Appellant asserts that these statements are in conflict. If "individuals have little trouble ranking items on a scale of one to five", then those individuals must already know the definition of a one or a two, must already understand what a one or a five mean, and must already understand how to apply the scale, else they could not perform the ranking, on which Examiner admits they "have little trouble". The understanding of the one to five scale is common knowledge, to the point of being used in the dictionary to illustrate a definition, and requires no further definition from Appellant.

Finally, in Table C on page 20, Appellant provides a sample questionnaire that includes five answers to each of the six factor questions on the questionnaire. These five answers provide further definition of the one to five scale, though it is clearly not needed for those skilled in the art to make use of the invention.

On the other hand, Table C inherently defines rankings on a scale of one to five and provides definitions for each ranking. For example, the specification explicitly states that "each trade secret may be characterized by a value, for example, a number on a scale of 1 to 5, using the descriptive labels and definitions

provided as a further example in Table C" (specification, page 20, lines 14-17). The first factor in Table C has the descriptive label "Inside Knowledge" followed by the question to be answered in evaluating the trade secret under the first factor (i.e., "To whom is the trade secret known in the company?"). Following the question to be evaluated under the first factor are five possible answers and a definition for each of the five answers. The first answer is "Whole Company" followed by the definition "Generally known within the company." The second answer is "Within Division" followed by the definition "Generally known within the originating division." The third answer is "Within Department" followed by the definition "Generally known within the originating department", the fourth answer is "Within Group" followed by the definition "generally known within the originating group", and the fifth answer is "Select Persons" followed by the definition "Known to select persons only." If a user should select the fifth answer, then the claimed system would assign the highest ranking on the scale of one to five for the factor. If the user should select the fourth answer, then the factor would receive the second highest ranking and so on.

Similarly, the second factor has the descriptive label "Outside Knowledge" followed by the question to be answered of "To whom is the trade secret known within the industry?" Following the descriptive label for the second factor are five possible answers. As with the first factor, each of the five possible answers for the

second factor has a definition associated with each answer. As with the first factor, selection of the first answer would receive the lowest possible ranking on the scale of one to five.

The third through sixth factors of a trade secret within Table C use the same process. In each case, the user selects an answer based upon the definition. In each case, the claimed system ranks the factor based upon the selection.

Table C provides five rankings and a definition for each ranking. As such, the ranking scale has been clearly defined in terms explicitly related to evaluating a trade secret. In addition, the criterion to be used for selecting a ranking for each factor of a trade secret is set forth in terms that are directly and explicitly related to the factor. As such, the ranking and criteria for determining a ranking is tangible, concrete and definite.

The second main point on which Examiner's argument rests is the subjective nature of the information input to the invention in response to the questionnaire provided to the user in the first claim step of each of the independent claims. This argument is not germane to the claimed invention, as the user's judgment lies outside of the clear language of the claims.

Quoting from the Examiner's Answer:

"The Examiner is unclear how the appellant can make the statement that the selection of a user input is not part of the claimed invention. Representative claim 96 clearly claims providing a questionnaire of six multiple-choice questions, providing a numerical score value to each of the

possible responses on the questionnaire, accepting responses through the input device in response to the questionnaire, converting the individual responses received to the numerical score values, calculating the geometric mean of the numerical score value[s] to create a single metric for the trade secret, repeating the steps for the plurality of trade secrets, and ranking the trade secrets in order of the calculated metric. Thus, the Examiner asserts that the user's judgment with respect to the six necessary component variables is the input." (Examiner's Answer, page 16)

The Examiner is exactly correct that the user's judgment with respect to the six necessary component variables is the input. The process of the user determining the input to the invention thus lies outside the scope of the invention. The claim language could not be more clear. Logically, if the user's judgment is the input to the invention, as Examiner admits, then the user's process in coming to that judgment must by definition lie outside the scope of the invention. That is, if the user comes to a judgment, and inputs that judgment into the invention, coming to that judgment lies outside of the invention or it would not need to be input.

Applying Examiner's argument to other devices in common use is instructive. A new type of remote control for televisions, a new type of numeric calculator, and a new type of GPS-based guidance system would all fail Examiner's test for patentability under this argument. Each of these devices requires user input to determine the output. Those inputs are subjective based on the judgment of the user. The output depends on the input in such a way as to render the output indeterminate if the user's subjective determination of the desired input is included in the scope of the

invention.

What each of these devices does is perform a well-defined action in response to an input. The determination of the input itself lies outside of the scope of the invention.

The analogy is exact. The user of Appellant's invention desires that an aggregation of his own (or another's) subjective input to the method be performed, and a ranked listing of trade secrets dependent on those judgments be produced. For a given input, the ranked listing is concrete, determinate and exactly reproducible.

As is generally known, those skilled in the art of evaluating trade secrets would not want and will not use a device that substitutes its own judgment (or its inventors' judgment) for their own. The potential users of Appellant's invention would want their own judgments processed in such a way as to make those judgments more easily considered and compared. For this reason, the scope of Appellant's invention does not include the evaluation process, which is clear from the language of the claims.

Having included the evaluation process in the scope of the invention in contradiction of the claims, the Examiner worries that "There is no proof that the subjective determination made in the human mind can be reliably and predictably quantified" (Examiner's Answer, page 22). On the other hand, the Examiner has offered no proof that a subjective determination made in the context of a trade secret in the human mind cannot be reliably and

predictably quantified. In this case, the burden is on the Examiner and the Examiner has failed to produce any evidence.

Moreover, the five answers to each of the six factors in Table C are generally measurable and quantifiable. Using the first factor of Table C, as an example, the Inside Knowledge of who knows about a trade secret within a company can be easily and objectively verified. The use of a trade secret within a specific subdivision of an organization provides an objective indication of Inside Knowledge. Similar indicators exist for the questions and answers for the other factors of a trade secret in Table C.

In general, the Examiner has failed to provide any rational basis for questioning the objectivity of the inputs in response to Table C. Since each of the answers in Table C is measurable and quantifiable, there is no basis for asserting that the invention does not produce a repeatable or concrete result, even if the evaluative process lies within the scope of the invention, which the claims make clear it does not.

Nor has Examiner offered any argument or evidence that all other questionnaires possible under the first element of the independent claims will fail to elicit objective answers.

With regard to Examiner's undue experimentation objection, quoting from the Examiner's Answer:

"Applicant states that the applicants expect that, with experience, users will come to an understanding of the threshold values that have most meaning within their business environment (page 28 of the appeal brief). The Examiner asserts that this provides further evidence that the invention

is not enabled due to the quantity of experimentation needed to make or use the applicant's invention." (Examiner's Answer, page 22).

First, Examiner's conclusion here is overbroad. The threshold values appear only in dependent claims 104, 113, and 118, and do not provide any evidence one way or the other with respect to the experimentation needed to make or use the invention under the other claims.

Second, there are $5 \times 5 \times 5 \times 5 \times 5 \times 5$, or 15,625, possible numeric values for the responses to the questions with regard to the six factors, only 270 of which result in a geometric mean greater than 4. How much experimentation does it take on the part of the user, if informed that there are thousands upon thousand of trade secrets in the system, scored on a value of 1 to 5, to say, "Let's start by looking at those with a score above 4"? Wouldn't this be the instinctive initial approach, requiring no experimentation at all? And if this results in only two trade secrets for his particular dataset, is it undue experimentation for him to then ask for all trade secrets scoring above 3.5?

Further, the setting of this threshold is once again an evaluative judgment that lies outside of the scope of the invention. The potential users of this system -- skilled judges, lawyers, and engineers -- do not want their judgment on the proper threshold value supplanted by that of the system (or its inventors). The threshold value is another input to the system.

Of course, as users gain experience with the invention,

their use of it will become more nuanced, as Appellant noted in the Appeal Brief. Isn't this to be expected with any invention? Is every user of a patentable invention able to use it to its greatest benefit on first use? If the user obtains strong benefit from using the invention the first time, and the benefits increase over time because his use has become more subtle and nuanced with experience, is the invention therefore unpatentable for requiring undue experimentation?

Appellant asserts that undue experimentation would not be required to use the invention defined by claims 104, 113, and 118, where the user is required to input threshold values, due to the common-sense and well-known nature of the 1 to 5 scaling method.

For all of the above reasons, Examiner's rejection on a lack of enablement to use the invention is therefore incorrect and should be overturned.

New information has become available to the Appellant since the Appeal Brief was filed over six months ago. An embodiment of the invention was constructed using the questionnaire of Table C as directed by the specification and Appendix I, and used to create a ranked listing of the trade secrets at issue in a trade secret misappropriation case currently before a state court. The questionnaire was provided through an output device (printer) to a technical employee of one of the litigants, who provided his evaluation of the six factors per the questionnaire for over 2500 trade secrets. Entering the 2500 trade secrets into the device was

performed by a paralegal in a single week.

The resulting ranked listing of trade secrets was spot checked by experienced trade secret litigators, and the highest-ranking trade secrets were given additional scrutiny. These checks verified that the ranked listing of trade secrets was correct and useful in the litigation. The ranked listing is being used to decide which trade secrets to litigate, simplifying the complex court case and focusing the parties on the major issues.

It should be noted that the person who performed the evaluation was a technical employee, not an attorney, and untrained in the legal definition of trade secrets. The questionnaire and its sample answers of Table C were the only training or guidance given. Further, the person who performed the evaluation was not the ultimate user of the ranked listing, the attorneys involved in the case were. The person entering the information into the machine was a paralegal, not an attorney, and performed data entry only, without any modification of the data.

This method of producing a trade secret listing is to be contrasted with manual methods, which Appellant knows by personal experience can take seasoned trade secret attorneys hundreds of hours to compile in cases of similar complexity. In contrast, this process took one week from the collection of the evaluative judgment, and required no attorney time at all.

While it is too late in the application process for the Appellant to provide a sworn affidavit as to these facts, there is

no benefit to Appellant to introduce into the record for this application any untrue facts that could be a basis for future hearing to invalidate any resulting patent. This experience provides further evidence that Examiner's objection on enablement grounds is incorrect and should be overturned.

The nub and crux of Examiner's argument for this rejection appears on page 18-19 of the Examiner's Answer:

"As admitted by the appellant, the answers to the questionnaire are subjective. Because of the subjective analysis, for a single situation, there could be different results based on the subjective analysis and determination of each user. The subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the resulting metric would be different and have a different meaning."

This is the core issue underlying the rejection of the application under 35 USC §112. The core issues before the Board with regard to this rejection are:

1) Is any invention that operates, in a well-defined and deterministic way, on user input unpatentable for failing to produce a concrete or tangible or reproducible or useful result because the output depends on the input?

2) Is there a lack of enablement in any invention whose output depends on the user input, despite an objective and deterministic processing of that input within the scope of the invention, for failure to achieve a uniform output across multiple users?

3) Does the ranking on the well-known, common-sense scale from 1 to 5 of the well-defined traits of a trade secret, which have been refined over sixty years of precedent and experience, or of the generated metric require any further explication in the specification in order to meet the enablement requirement?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The device would provide different outputs for different input by different users, as it is the aggregation of the user's judgment that is the desired output of the device. Making these subjective judgments on a 1 to 5 scale is well within the abilities of those skilled in the art of evaluating trade secrets, even without the textual answers provided in Table C of the specification on pages 20-22. Similarly, understanding the numerical score value calculated with the geometric mean, which results in a value between 1 and 5, is also well within the abilities of those skilled in the art. Examiner's argument for rejection on these grounds is therefore inapposite and incorrect and should be overturned.

The reader's attention is now directed to the rejection of Claims 96-101, 103-110 and 112-118 under 35 USC §101. In the argument for rejection in the Examiner's Answer, Examiner relies upon two exclusive formulations of Appellant's invention. Examiner first argues that the invention includes the evaluative judgments

of the users on the six factors: "clearly these determinations are not outside of the claimed invention and thus are relevant in making any determinations as to the patentability of the claimed invention" (Examiner's Answer, page 26). Applying further analysis in the same argument, Examiner asserts Appellant's invention includes nothing more than the calculation of a geometric mean: "Examiner asserts the appellant's invention is nothing more than a mathematical formula used to provide a ranking...." (Examiner's Answer, page 34) Further along, Examiner reverts to the earlier formulation: "The subjective component of appellant's invention is not amenable to reproducibility of a result" (Examiner's Answer, page 37).

The first and third assertions are exclusionary of the second, and cannot all be logically applied at different points in developing the same argument.

Further, neither of these formulations is the Appellant's invention as defined by the claims.

The Appellant's invention is a method for creating a ranked listing of trade secrets through, inter alia, the steps of providing a questionnaire based on the six factors of a trade secret, receiving the answers, applying numeric values, calculating a metric using the geometric mean, and ranking the results.

For the first and third of Examiner's assertions to be correct, the invention must include an evaluative process that lies outside the scope of the claim language. Appellant does not claim

the evaluative process as part of the invention. The claim language of the independent claims does not read on the evaluative process, and Examiner's assertion in the first part of the argument for rejection on these grounds, "clearly these determinations are not outside of the claimed invention", is incorrect, as is the "subjective component of appellant's invention" in the third part of the argument.

Furthermore, as discussed above, even if the "subjective component of applicant's invention" were a part of the claimed invention (which it is not), the Examiner has failed to provide any basis that selecting answers in the context of Table C is subjective and not reproducible. Alternatively, Examiner's "subjective component" is based upon measurable and quantifiable data with a repeatable and concrete output.

For the second of Examiner's assertions to be correct, the invention must not include provision of a questionnaire based on the six factors of a trade secret, receiving the answers, and applying numerical scores. Appellant explicitly claims these steps as integral parts of the invention. The claim language of the independent claims clearly includes these steps, and Examiner's assertion in the second part of the same argument for rejection on these grounds, "appellant's invention is nothing more than a mathematical formula used to provide a ranking", is incorrect.

Either of Examiner's formulations is proven inapposite by the claim language, and Examiner's argument fails. Further, using

both of these exclusionary formulations in different steps of the same argument is a logical failure that renders the argument invalid.

The nub and crux of Examiner's argument for this rejection appears on page 44 of the Examiner's Answer: "Because each user is making a subjective analysis and entering the numerical score values based on this subjective analysis, any metric produced using these values and any ranking resulting from the use of the metric would not be concrete since it is hard to reproduce another's subjective determination."

This is the core issue underlying the rejection of the application under 35 USC §101. The core issues before the Board with regard to this rejection are:

1) Is any invention that operates, in a well-defined and deterministic way, on user input unpatentable for failing to produce a concrete or tangible or reproducible or useful result because the output depends on the input?

2) Is any invention that uses a mathematical formula as one of its claim steps unpatentable as merely "a novel and useful mathematical formula", irrespective of the other claim steps?

3) Does the output of the invention, a listing which ranks trade secrets on the familiar, common-sense scale from 1 to 5, require any further explication in the specification in order to be considered a useful and concrete result?

4) Must the claim language be strictly read in

determining the patentability of an invention, so as to include all elements on which the claims read and exclude all elements on which the claims do not read?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The Examiner is arguing against patentability based upon what the Examiner considers the gist of the invention, rather than the invention defined by the claim language. Examiner's argument for rejection on these grounds is therefore inapposite and should be overturned.

The reader's attention is now directed to the rejection of Claims 96, 103-105, 112-114 and 118 under 35 USC §103(a) as being unpatentable over Spencer in view of Barney. In the Examiner's Answer, Examiner notes that Appellant's specification, which was written well prior to the current claim language, discusses multiple methods for determining the metric: "the assigned values may be averaged to provide the relevant metric. Alternatively, the six assigned values may be multiplied and the sixth root taken of the product." Examiner also states, erroneously, that this statement was repeated by Appellant in the Remarks submitted with the amendment filed on February 10, 2005. Appellant in fact merely quoted from the specification in response to Examiner's assertion that the specification did not describe how the metric is generated (Non-Final Rejection of 10-06-2004, page

3).

Examiner's comment that "it appears that several methods of obtaining the relevant metric may work equally as well as the geometric means" is inapposite to the claimed invention. What is claimed is an invention that, inter alia, calculates the metric from the geometric mean, which Appellant has determined is particularly appropriate to the analysis of the six factors of trade secrets. None of the claims refers to or includes the calculation of the metric using other methods.

Appellant's pointed question in the Appeal Brief remains unanswered in Examiner's Answer: "How obvious is the selection of a single mathematical calculation out of tens of thousands of possibilities, all of which are 'old and well-known', as being peculiarly appropriate for the creation of ranking criteria for trade secrets?" The use of the geometric mean, which Examiner admits is not disclosed by Barney or Spencer, differentiates Appellant's invention from the prior art.

Examiner here argues that the use of the geometric mean to evaluate trade secrets would be obvious to those skilled in the art, despite it being disclosed by neither Barney nor Spencer, and simultaneously argues in the other rejections that the use of a 1 to 5 scale for ranking either trade secrets or the six factors, which is disclosed in Appellant's specification, is so obscure that those skilled in the art would be unable to use the invention without further guidance and direction. Appellant asserts that not

only are both assertions incorrect, but further that Examiner has argued both that those skilled in the art are unaware of common English usage for a well-understood ranking concept on the one hand, and can routinely apply sophisticated statistical techniques of data analysis to that same ranking on the other. That is, in Examiner's view those skilled in the art would find it obvious to use the geometric mean to aggregate scores on a simple one-to-five scale *that they do not understand*. Appellant asserts that this is a logical impossibility that undermines Examiner's arguments for one, the other, or both rejections.

In considering the obviousness of the use of the geometric mean for evaluating trade secrets, it should be noted that there are 15,625 possible combinations of responses to the questionnaire in Table C of the specification, resulting in numerical scores for the six factors for each trade secret on a scale of 1 to 5, from (1, 1, 1, 1, 1, 1) to (5, 5, 5, 5, 5, 5). The summing method of Spencer applied against these possible numerical scores results in a symmetric curve centered around the middle of the 6-30 range at 18, while the geometric mean of the claimed invention results in a non-symmetric curve with a peak below the midpoint of the 1-5 range at 2.5, and a longer and narrower tail toward the upper values. This shift to the left and longer upper tail provides more differentiation among metrics toward the top of the range, where the valuable trade secrets are, while compressing the metrics at the lower end of the range, which

contains lesser trade secrets and is therefore of less interest.

In detail, the geometric mean results in 270 of the 15,625 possible numerical scores falling in the upper quarter of the range, above 4.0. In contrast, Spencer's summing method results in 456 of the possible numerical scores falling in the upper quarter of the range, above 24. The geometric mean thus provides a longer tail at the high end of the range, with fewer of the possible numerical scores falling in the upper quarter, and therefore provides greater distinction among trade secrets at the top of the range than the summing method disclosed in Spencer.

Further, the summing method of Spencer provides only 6 possible output values in the upper quarter, into which those 456 possible numerical scores fall, for an average of 76 possible numerical scores per discrete metric value in the upper quarter. The geometric mean, by contrast, provides 15 possible output values in the upper quarter, into which those 270 possible numerical scores fall, for an average of only 18 possible numerical scores per discrete metric value in the upper quarter. This further demonstrates the greater distinction among trade secrets at the top of the range provided by the geometric mean compared to the summing method disclosed in Spencer.

Finally, the summing method disclosed in Spencer gives the same metric of 21 to trade secrets with numerical scores of (4, 4, 4, 3, 3, 3) and (4, 4, 4, 4, 4, 1). The geometric mean gives a metric of 3.46 to the former, but only 3.17 to the latter. That

is, the geometric mean reflects that scoring somewhat lower on three of the factors is not as damaging to the metric as scoring very low on a single factor, even though the sum of the factor scores is the same. Indeed, even numerical scores of (4, 4, 3, 3, 3, 3) rank significantly higher (geometric mean = 3.30, Spencer summing method = 20) than (4, 4, 4, 4, 4, 1) (geometric mean = 3.17, Spencer summing method = 21) using the geometric mean, the opposite of the result with the summing method of Spencer. This differentiation echoes the judgment of experienced trade secret litigators, who consider medium to strong compliance across all six factors as being preferred to strong compliance on five factors and very weak compliance on the remaining factor.

Do these features of the geometric mean make the use of the geometric mean obvious in light of Spencer? The use of the geometric mean would also provide benefits to Spencer's method of evaluating RFP responses. More differentiation among the high-scoring RFPs would make the distinction among the highest-scoring respondents easier. Further, it would also seem to be of benefit in Spencer to rate an RFP that was medium to strong across the board above one that was strong across the board but scored very poorly in one required area. Yet Spencer did not disclose the geometric mean. If the use of the geometric mean is obvious, it was not obvious to Spencer.

Appellant argues that the use of the geometric mean is not obvious in light of Spencer, as asserted by Examiner.

Spencer's failure to disclose the geometric mean, which would provide similar benefits to his method, is telling. It was Appellant's rigorous evaluation of numerous mathematical functions out of the tens of thousands possible that revealed the geometric mean as being particularly suited to the scoring of trade secrets in Appellant's invention.

As the use of the geometric mean is not obvious over Spencer in light of Barney, Examiner's rejection on grounds of obviousness over Spencer in light of Barney is incorrect and should be overturned.

With regard to the questionnaire being based on the six factors of a trade secret from the Restatement (First) of Torts, which Examiner admits is not disclosed in either Barney or Spencer, Examiner merely repeats the assertions of the Final Rejection in the Examiner's Answer, dismissing the content of the questionnaire as non-functional descriptive data. Examiner repeats the references to the cases of *In re Gulack* and *In re Lowry* without argument. Appellant's arguments in the Appeal Brief to the contrary, and in particular appellant's discussion of *In re Gulack* and *In re Lowry* as well as *In re Miller* on which they depend, are not addressed at all. The Board is directed to Appellant's discussion in the Appeal Brief.

Appellant's arguments in the Appeal Brief with regard to this rejection on obviousness grounds thus remain completely unaddressed in Examiner's Answer.

The core issues before the Board with regard to this rejection are:

1) Must the claim language be strictly read in determining the patentability of an invention, so as to include all elements on which the claims read?

2) Does the questionnaire's reliance on the six factors of a trade secret from the Restatement (First) of Torts, in order to produce the useful result of a ranked listing of trade secrets per the user's evaluation of those criteria, meet the functional relationship test of Miller?

3) Is the selection of the geometric mean, out of the tens of thousands of "old and well-known" mathematical formula available, as particularly suited to the ranking of trade secrets obvious in the light of Spencer's use of a simple summing for the ranking of RFPs?

Appellant asserts that the correct answers to these questions leave Examiner's argument for rejection on these grounds without foundation. The Examiner has discarded functional claim language and ignored the importance and differentiation of the geometric mean in finding Appellant's invention unpatentable over Spencer in view of Barney. Both of Examiner's arguments must be correct for Appellant's invention to be rejected on obviousness grounds, and neither is correct. Examiner's rejection on these grounds is therefore incorrect and should be overturned.

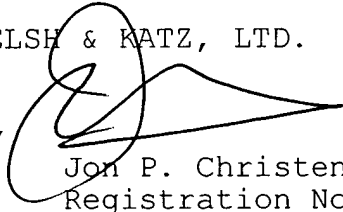
For the foregoing reasons, allowance of claims 96-101,

103-110 and 112-118, as now presented, is believed to be in order.
It is respectfully requested that this Board reverse the decision of
the Examiner in all respects.

Respectfully submitted,

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By



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June 25, 2007
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